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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/765,649	01/26/2004	Ronald Paul Rohrbach	HO1-0010	1181
23413	7590	09/20/2006	EXAMINER	
CANTOR COLBURN, LLP 55 GRIFFIN ROAD SOUTH BLOOMFIELD, CT 06002			CINTINS, IVARS C	
			ART UNIT	PAPER NUMBER
			1724	

DATE MAILED: 09/20/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/765,649

Applicant(s)

ROHRBACH ET AL.

Examiner

Ivars C. Cintins

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application
- ☐ Other: _____.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1, 2, 4-11 and 13-15 are again rejected under 35 U.S.C. 103(a) as being unpatentable over Brownawell et al. (U.S. Patent No. 5,069,799; hereinafter "Brownawell '799"). As pointed out in the previous Office action, Brownawell '799 discloses an oil filter comprising a hollow housing having an inlet and an outlet, a mechanically active filter member (i.e. "inactive filter media" 12) disposed inside the housing, and a chemically active filter member (i.e. 14) disposed inside this housing. This reference further discloses an embodiment (see Fig. 2) having a supplemental cartridge with a chemically active filter member (i.e. 30) disposed therein. The chemically active filter member includes a plurality of particles (see col. 2, line 6) containing a beneficial additive such as a basic salt of the type recited (see col. 2, lines 12-17). This reference further teaches that the chemically active filter media may include a polymeric binder (see col. 2, line 2). Accordingly, this reference discloses the claimed invention with the exception of the diameter of the particles in the chemically active filter member, the percentage of polymeric binder present, the percentage of basic salt in these particles, and the specific polymer binder employed (claims 2 and 14). However, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ particles having the recited diameter, polymeric binder content, and basic salt content in the reference system, in order to optimize the

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treatment capability of these particles. Applicant should note that the particles in the Brownawell '799 device will inherently have some particle size, some percentage of polymeric binder, and some percentage of basic salt. Since the record does not show that Applicant is able to obtain a new and unexpected result from the recited combination of particle size, polymer binder percentage and basic salt percentage, it would have been obvious to one of ordinary skill in the oil treatment art to select the recited values for these parameters in the system of Brownawell '799, in order to obtain results which are commensurate with such selected values. Also, it would have been obvious to one of ordinary skill in the art at the time the invention was made to employ any of the polymeric materials recited in claims 2 and 14 as the "polymer matrix" of Brownawell '799 (see col. 2, line 2), since these polymeric materials are capable of supporting the calcium carbonate or calcium hydroxide of the primary reference in the required manner.

Claim 3 is again rejected under 35 U.S.C. 103(a) as being unpatentable over Brownawell '799 as applied above, and further in view of Bilski et al. (U.S. Patent No. 5,725,031; hereinafter "Bilski"). As pointed out in the previous Office action, Brownawell '799 as modified above discloses the claimed invention with the exception of the recited location of the chemically active filter element with respect to the mechanically active filter element. Bilski discloses a similar oil filter containing both a mechanically active filter element and means for adding a chemical to oil undergoing treatment, and further discloses (see Fig. 1) locating the chemical adding element radially and coaxially inside the mechanically active filter element. It would have been obvious to one of ordinary

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skill in the art at the time the invention was made to locate the chemically active filter element (i.e. 14) of Brownawell '799 inside the mechanically active filter element (i.e. 12), as suggested by Bilski, in order to produce a more compact filtration and treatment device.

Claim 12 is again rejected under 35 U.S.C. 103(a) as being unpatentable over Brownawell '799 and DeJovine as applied above, and further in view of Robers et al. (U.S. Patent No. 5,544,699; hereinafter "Robers"). As pointed out in the previous Office action, the modified primary reference discloses the claimed invention with the exception of the recited auxiliary inlet and outlet tubes. Robers discloses an oil filter having auxiliary inlet and outlet tubes (42 and 44), in order to cool the oil in the system. It would have been obvious to one of ordinary skill in the art at the time the invention was made to provide the system of the modified primary reference with the cooling arrangement of Robers, in order to obtain the advantages disclosed by this secondary reference for the system of the modified primary reference.

Applicant's arguments filed July 11, 2006 have been noted and carefully considered but are not deemed to be persuasive of patentability. Applicant argues that there is no teaching or suggestion in Brownawell of the specific filter claimed by Applicants, namely one having the recited size range, amount of basic salt, and amount of binder. It is pointed out, however, that the particles in the chemically active filter member of Brownawell '799 must inherently have some average diameter. Since particles having an average diameter significantly below 0.1 millimeters could cause handling problems in the reference device, because powders are more difficult to

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handle than are larger granules; and since particles having an average diameter significantly above 5 millimeters could cause problems in the reference device, because the interstitial space between these particles could be too great to produce adequate contact between the chemically active media and the oil undergoing treatment; one of ordinary skill in the fluid purification art would have been motivated to select particles having an average diameter within the recited range, in order to avoid the above noted problems. Similarly, the particles in the Brownawell '799 device will inherently have some percentage of polymeric binder, and some percentage of basic salt; and, it would have been obvious to one of ordinary skill in the oil treatment art to select the recited values for these parameters in the system of Brownawell '799, in order to obtain results which are commensurate with such selected values.

Applicant's argument that the claimed particle size and binder content is specifically formulated to allow the controlled release of basic conditioner into the hot oil flowing past the basic conditioner in the chemically active filter is not deemed to be persuasive, since the reference system also appears to release this same basic conditioner into the oil undergoing treatment.

Applicant's response enumerates several purported advantages over the prior art system. However, Applicant has provided no evidence, such as comparative data, to support such allegations and conclusions. Mere conclusory statements, unsupported by objective evidence, are entitled to little weight in determining patentability. Cf. *In re Greenfield*, 571 F.2d 1185, 1188, 197 USPQ 227, 229 (CCPA 1978).

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.


Any inquiry concerning this communication or earlier communications from the examiner should be directed to I. Cintins whose telephone number is 571-272-1155. The examiner can normally be reached on Monday through Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mr. Duane Smith, can be reached at 571-272-1166.

The centralized facsimile number for the USPTO is **571-273-8300**.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

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you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Ivars C. Cintins
Primary Examiner
Art Unit 1724

I. Cintins
September 17, 2006